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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91160266
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In the Matter of Application Serial No. 75/761,159
Mark: CAB CALLOWAY
Opposer's Ref: CWBK 04/18950

TRIAL BRIEF FOR OPPOSER

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I. INTRODUCTION

The issues in this case have been narrowed by stipulation of the parties to one question and one question only: whether Opposer can establish prior rights in THE CAB CALLOWAY ORCHESTRA. The similarities of the parties' marks THE CAB CALLOWAY ORCHESTRA and CAB CALLOWAY is not disputed. The similarity of the Parties' goods and services is not disputed. Indeed, the parties recognize and have stipulated that if Opposer satisfies its burden of proof on the issue of priority, the Opposition must be sustained.

As to the sole question of priority, the evidence is clear, unambiguous, and unchallenged. Opposer Christopher Brooks ("Opposer" or "Mr. Brooks") is Cab Calloway's eldest grandson. With the blessing and approval of his grandfather Mr. Brooks founded a jazz orchestra, THE CAB CALLOWAY ORCHESTRA, of which he is and always has been the sole proprietor. Beginning in 1998, and continuously since then, Mr. Brooks has performed under the name THE CAB CALLOWAY ORCHESTRA and has sold musical recordings bearing that name at various venues and events throughout the U.S. and around the world. The use that Mr. Brooks made of THE CAB CALLOWAY ORCHESTRA in December 1998, in combination with his subsequent, deliberate, and continuous use, establishes his rights in THE CAB CALLOWAY ORCHESTRA as of December 1998. Applicant cannot prove rights that predate those of Opposer.

On July 23, 1999, seven months *after* Opposer began his use of THE CAB CALLOWAY ORCHESTRA, Applicant Creative Arts by Calloway, LLC ("Applicant"), through its predecessor in interest, filed the intent-to-use application at issue in this action, Serial No. 75/761,159 (the "Application"), to register CAB CALLOWAY for various goods and services, eventually including "distribution of pre-recorded music, drama, comedy and variety shows on video tapes, cassettes, digital video and audio discs and CD-ROM," "production and distribution of live music concerts, comedy, and dramatic series," and "production of videotapes and sound

recordings, namely, phonograph records, pre-recorded audio tapes, compact discs, videotapes, digital audio tapes, compact disc videos, and laser discs.” For purposes of determining the only issue in this case, priority, the only date on which Applicant does and can rely is the Application filing date. No evidence and no legal argument can change the established fact that Opposer acquired rights in THE CAB CALLOWAY ORCHESTRA prior to Applicant’s filing date.

Because the unopposed and undisputed evidence Opposer has introduced shows Opposer’s use of THE CAB CALLOWAY ORCHESTRA prior to July 23, 1999, judgment should be entered in his favor, and Applicant’s application must be refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

II. DESCRIPTION OF THE RECORD

A. Stipulations of the Parties

On July 1, 2008, the parties filed a stipulation (approved by the Board by Order dated July 3, 2008, TTABVUE # 40):

(1) That “the sole issue before the Board in this opposition is whether Opposer can establish rights in THE CAB CALLOWAY ORCHESTRA prior to the filing date of the opposed application, which is July 23, 1999.” (*See* Stipulation as to Facts and Agreement to Submit Opposer’s Testimony by Affidavit, dated and filed July 1, 2008, TTABVUE # 41, at 1.)

(2) To the facts of this case other than priority. (*See id.*, Ex. A (“Stip. of Facts”).)

(3) That Opposer’s testimony could be introduced by affidavit, and to the admission into evidence without objection of Opposer’s affidavit and the exhibits thereto. (*See id.*, Ex. B.)

(4) That the testimony of three witnesses for Opposer, Kuni Mikami, Troy Burton, and Monty Zullo, could be submitted by declaration, and to the admission into evidence without objection of those witnesses’ declarations and the exhibits thereto. (*See* Stipulation and

Agreement to Submit Testimony of Witnesses Called by Opposer by Declaration, dated and filed July 1, 2008; TTABVUE # 39.)

B. Opposer's Evidence

1. Opposer submitted testimony and exhibits through a trial affidavit and trial declarations of the following witnesses:

(A) Christopher Brooks, the Opposer in this Action and the sole proprietor of THE CAB CALLOWAY ORCHESTRA, by the Affidavit of Opposer Christopher Brooks to be Submitted as Trial Testimony dated June 30, 2008, together with the Exhibits referenced therein and identified below ("Brooks Aff.," TTABVUE #41 at 8-95):

EX. 1 – Opposer's press packet for THE CAB CALLOWAY ORCHESTRA.

(TTABVUE #41 at 12-59.)

EX. 2 – Redacted copies of contracts for services by THE CAB CALLOWAY ORCHESTRA entered into prior to July 23, 1999, and carbon receipts of checks paid to the members of the Orchestra, dated April 21, 1999, for one such performance.

(TTABVUE #41 at 60-68.)

EX. 3 – March 21, 2001 letter from the manager of the Sleepy Hollow Country Club noting performances of THE CAB CALLOWAY ORCHESTRA since 1998.

(TTABVUE #41 at 69-70.)

EX. 4 - January 7, 1999 invoice from the Eubie Blake National Jazz Institute & Cultural Center identifying THE CAB CALLOWAY ORCHESTRA. (TTABVUE #41 at 71-72.)

EX. 5 – Redacted copies of Opposer’s 1998 and 1999 Schedule C tax forms for “Cab Calloway Orchestras,” the business name used for performing groups including THE CAB CALLOWAY ORCHESTRA. (TTABVUE #41 at 73-77.)

EX. 6 – 1999 CD branded with the mark THE CAB CALLOWAY ORCHESTRA. (TTABVUE #41 at 78-79 [hard copy provided to the Board on July 1, 2008].)

EX. 7 - March 20, 1999 invoice showing manufacture of compact discs under the mark THE CAB CALLOWAY ORCHESTRA; March 30, 1999 production memo for the recording of CD and video; and April and May 1999 receipts for the sale of CDs bearing the mark THE CAB CALLOWAY ORCHESTRA. (TTABVUE #41 at 80-86.)

EX. 8 - 1999 video bearing the mark THE CAB CALLOWAY ORCHESTRA. (TTABVUE #41 at 87-88 [hard copy provided to the Board on July 1, 2008].)

EX. 9 - March 20, 1999 invoice showing the manufacture of videotapes under the mark THE CAB CALLOWAY ORCHESTRA; March 30, 1999 production memo for the recording of CD and video, and April and May 1999 receipts for the sale of videotapes bearing the mark THE CAB CALLOWAY ORCHESTRA. (TTABVUE #41 at 89-95.)

(B) Kuni Makami, a professional jazz pianist who has performed with Mr. Brooks in THE CAB CALLOWAY ORCHESTRA since 1998, by the Declaration of Kuni Mikami to be Submitted as Trial Testimony dated June 16, 2008 (“Mikami Decl.,” TTABVUE #39 at 4-6).

(C) Troy Burton, the Executive Director of the Eubie Blake National Jazz Institute and Cultural Center, who booked and attended a performance of THE CAB CALLOWAY ORCHESTRA in 1999 prior to the filing date of the Application, by the Declaration of Troy Burton to be Submitted as Trial Testimony dated June 18, 2008, together with the Exhibits referenced therein and identified below (“Burton Decl.,” TTABVUE #39 at 8-13):

EX. A – Redacted March 2, 1999 contract for the Orchestra’s performance under the mark THE CAB CALLOWAY ORCHESTRA on May 19, 1999. (TTABVUE #39 at 10-11.)

EX. B – May 19, 1999 receipt for Mr. Burton’s purchase of CDs and videos bearing the mark THE CAB CALLOWAY ORCHESTRA. (TTABVUE #39 at 12-13.)

(D) Monty Zullo, a Broadway producer and entrepreneur who distributed a press packet concerning THE CAB CALLOWAY ORCHESTRA, attended a performance of THE CAB CALLOWAY ORCHESTRA, and purchased recordings sold under the mark THE CAB CALLOWAY ORCHESTRA all in 1999 and all prior to the filing date of the Application, by the Declaration of Monty Zullo to be Submitted as Trial Testimony dated June 17, 2008, together with the Exhibit referenced therein and identified below. (“Zullo Decl.,” TTABVUE #39 at 15-18).

EX. A – May 22, 1999 receipt for Mr. Zullo’s purchase of CDs and videos bearing the mark THE CAB CALLOWAY ORCHESTRA. (TTABVUE #39 at 17-18.)

Applicant chose not to cross-examine any of Opposer’s witnesses, and offers no evidence to rebut the facts set forth in their sworn declarations.

2. On July 1, 2008, Opposer submitted a Notice of Reliance on (i) articles concerning Opposer’s use of and media coverage of THE CAB CALLOWAY ORCHESTRA, (ii) admissions by Applicant that the individual Cab Calloway was “an international jazz icon” and that Opposer had used THE CAB CALLOWAY ORCHESTRA mark in connection with CDs and videos prior to the Application filing date, and (iii) third-party applications and ensuing registrations for other ORCHESTRA marks, together with the Exhibits referenced therein and identified below. (Opposer’s Notice of Reliance, dated and filed July 1, 2008 (“Opp. Notice”), TTABVUE #38 at 1-93):

EX. 1 - October 5, 1984 article from *The Boston Globe* noting Opposer's upcoming concert performance with his grandfather Cab Calloway. (TTABVUE #38 at 6-9.)

EX. 2 - May 25, 1992 excerpt from *Jet* magazine noting Opposer's charity performance with his grandfather Cab Calloway. (TTABVUE #38 at 10-11.)

EX. 3 - October 5, 2000 article from *The New York Amsterdam News* noting the upcoming performance of Opposer, "Cab's heir," and his band THE CAB CALLOWAY ORCHESTRA at the "All Nite Soul Jazzfest." (TTABVUE #38 at 12-14.)

EX. 4 - October 14, 2000 article from *The Washington Times* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA and noting its upcoming performance at the opening ceremony for the new Eubie Blake National Jazz Institute and Cultural Center in Baltimore, Maryland. (TTABVUE #38 at 15-18.)

EX. 5 - September 20, 2002 article from *The Chicago Tribune* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA and noting its upcoming performance at the Prairie Center for the Arts in Schaumburg, Illinois. (TTABVUE #38 at 19-21.)

EX. 6 - November 8, 2002 article from *The Boston Globe* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA and noting its upcoming performance at a charitable event in Boston, Massachusetts. (TTABVUE #38 at 22-25.)

EX. 7 - June 23, 2005 article from *The Charleston Gazette* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA and noting its upcoming performance at the Charleston Marriott in Charleston, North Carolina. (TTABVUE #38 at 26-27.)

EX. 8 - July 2, 2005 article from *The Charleston Gazette* noting the performance of Opposer's band, the "[n]ationally known act[]" THE CAB CALLOWAY ORCHESTRA, at the FestivALL in Charleston, North Carolina. (TTABVUE #38 at 28-30.)

EX. 9 - February 19, 2006 article from *The Paducah Sun* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA and noting its two performances at a Kentucky college. (TTABVUE #38 at 31-33.)

EX. 10 - November 9, 2007 article from *The St. Petersburg Times* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA, observing that “[t]he orchestra is in the process of wrapping up a centennial anniversary tour that has taken it around the globe,” and noting its upcoming performance in Brooksville, Florida. (TTABVUE #38 at 34-36.)

EX. 11 - April 4, 2008 article from *The Albuquerque Journal* discussing Opposer and his band THE CAB CALLOWAY ORCHESTRA, describing THE CAB CALLOWAY ORCHESTRA as “world famous” and “a big time jazz band” that will “give the kids an experience of live music and big band jazz because it’s kind of a lost art,” and noting its upcoming performance at a high school in New Mexico. (TTABVUE #38 at 37-39.)

EX. 12 - Applicant’s July 8, 2005 Response to Opposer’s Statement of Undisputed Material Facts in connection with its opposition to Opposer’s motion for summary judgment in this proceeding, admitting (at ¶¶ 9-11) that Opposer sold CDs and videos bearing the mark THE CAB CALLOWAY ORCHESTRA prior to the July 23, 1999 Application filing date. (TTABVUE #38 at 40-54.)

EX. 13 - Applicant’s June 24, 2005 Declaration of Cabella Calloway Langsam in Support of Applicant’s Opposition to Opposer’s Motion for Summary Judgment in this proceeding, admitting (at ¶¶ 2-7) Cab Calloway’s fame, and that he was an “international jazz icon.” (TTABVUE #38 at 55-61.)

EX. 14 – A TARR printout of Reg. No. 2,459,428, for COUNT BASIE ORCHESTRA, together with a TARR printout of the prosecution history for the application (Serial No. 75/906,651), and the application, office action, and response. (TTABVUE #38 at 62-76.)

EX. 15 – A TARR printout of Reg. No. 2,438,337 for TOMMY DORSEY ORCHESTRA, together with a TARR printout of the prosecution history for the application (Serial No. 75/890,818), and the application, office actions/amendments, and response. (TTABVUE #38 at 77-93.)

C. Applicant's Evidence

Applicant's evidence consists solely of a Notice of Reliance on (i) the parties' stipulation of facts (identical to (A)(2) above), and (ii) certain excerpts from Mr. Brooks' legal memoranda submitted in prior litigation between the parties in the U.S. District Court for the Southern District of New York and the U.S. Court of Appeals for the Second Circuit, which Applicant claims serve as admissions against interest. (*See* Applicant's Notice of Reliance, dated and filed October 6, 2008 ("App. Notice"), TTABVUE #45.)

The "admissions" Applicant seeks to introduce and rely upon should not be considered by the Board. While Applicant cites in its Notice various provisions from the Trademark Rules of Practice and Trademark Trial and Appeal Board Manual of Procedure in support of the Board's consideration of these excerpts (App. Notice ¶ 2), most of those provisions relate to the submission of exhibits to pleadings or briefs (37 C.F.R. § 2.122(c), TBMP § 704.05), statements in pleadings (TBMP § 704.06(a)), official records (TBMP § 704.07), or "adjudicative facts" of which the Board might take judicial notice (TBMP § 704.12). The statements in the Notice fit into none of these categories. While they are "statements in briefs," they are not "[f]actual statements," *see* TBMP § 704.06(b), let alone factual statements made by Opposer *in this*

proceeding about Opposer's own rights in THE CAB CALLOWAY ORCHESTRA in connection with his goods or services. *Cf.* 37 C.F.R. § 2.122(f); TBMP § 704.13 (even sworn testimony from another proceeding not admissible as evidence at trial except by motion granted by the Board). Rather, they are *legal* arguments from memoranda submitted to the U.S. District Court for the Southern District of New York and U.S. Court of Appeals for the Second Circuit concerning whether Applicant's or its predecessors' purported use of "Cab Calloway" *to refer to the individual Cab Calloway or his works* was protectable *under the law of that circuit*. Opposer therefore objects to the introduction into evidence of these irrelevant and immaterial statements concerning his interpretation of the law of the Second Circuit, and to the Board's reliance on such materials.

III. STATEMENT OF THE ISSUES

The only issue before the Board is whether Opposer can establish rights in THE CAB CALLOWAY ORCHESTRA prior to Applicant's filing date for the Application, July 23, 1999. (Stipulation as to Facts and Agreement to Submit Opposer's Testimony by Affidavit, dated and filed July 1, 2008, TTABVue # 41 at 1.) As shown below, the uncontroverted evidence proves that Opposer has in fact established rights in THE CAB CALLOWAY ORCHESTRA at least as early as December 1998, prior to the Application filing date.

IV. RECITATION OF THE FACTS

A. Opposer's Rights in THE CAB CALLOWAY ORCHESTRA

1. Opposer and the Founding of THE CAB CALLOWAY ORCHESTRA

Opposer is the eldest grandson of the internationally famous jazz musician Cab Calloway, who died in 1994. (Stip. of Facts ¶ 1; *see* Opp. Notice Ex. 13, ¶¶ 2-7) (noting Cab Calloway's extraordinary fame, and describing him as "international jazz icon"). Opposer is a professionally-trained musician who has performed with various jazz greats and jazz orchestras,

and who has taught music theory classes and given music workshops at, among other locales, Harvard University and the New England Conservatory of Music. (Brooks Aff. ¶¶ 2-3.) Prior to Cab Calloway's death, Opposer repeatedly performed with his grandfather at venues ranging from private parties to the Kennedy Center and Lincoln Center. (*Id.* ¶¶ 3-4; Opp. Notice, Exs. 1-2 (articles discussing Opposer's performances with Cab Calloway).)

By December 1998 Opposer, with the encouragement and permission of Cab Calloway, had created and named his jazz orchestra THE CAB CALLOWAY ORCHESTRA ("the Orchestra") in his grandfather's honor. (Brooks Aff. ¶ 5.) Mr. Brooks is the sole proprietor, musical director, and lead performer of the Orchestra, which performs a variety of jazz music, including songs written and recorded by Cab Calloway, standards by a number of other artists, and Opposer's own original songs and arrangements. (*Id.* ¶¶ 5, 7, Ex. 5; Stip. of Facts ¶ 3; *see generally* Brooks Aff. ¶ 2, Ex. 1 (Orchestra press packet)). Opposer has used THE CAB CALLOWAY ORCHESTRA in connection with the Orchestra's musical performances in the U.S. continuously and deliberately from the date of its adoption. (Stip. of Facts ¶ 4.)

2. Opposer's Use of THE CAB CALLOWAY ORCHESTRA in Connection With Entertainment Services

In December 1998, seven months prior to the July 23, 1999 filing of the Application, Mr. Brooks performed with his orchestra under the name THE CAB CALLOWAY ORCHESTRA at the Sleepy Hollow Country Club in Scarborough, New York. (Brooks Aff. ¶ 6, Exs. 2 (fully executed 9/25/98 contract for 12/19/98 performance by Opposer and "the Cab Calloway Orchestra"); 3 (3/21/01 letter from Sleepy Hollow Country Club manager noting performances of "the Cab Calloway Orchestras" there "since 1998"); Mikami Decl. ¶¶ 4, 6 (noting December 19, 1998 Orchestra show and use of THE CAB CALLOWAY ORCHESTRA in connection with

that performance.)¹ Opposer reported this early use on his tax returns filed for the year 1998. (Brooks Aff. ¶ 7, Ex. 5 (noting “[b]usiness name” as “CAB CALLOWAY ORCHESTRAS” and “[p]rincipal business or profession, including product or service” as “[m]usic.”))

By March 1999, still prior to the filing of the Application, Monty Zullo, a Broadway producer, prepared a press packet advertising and promoting Opposer’s THE CAB CALLOWAY ORCHESTRA, and distributed that packet to his various industry contacts, including at Time Warner, William Morris, and ICM, among others. (Zullo Decl. ¶ 4.) Performances of THE CAB CALLOWAY ORCHESTRA continued, including for the United Jewish Appeal in Rye, New York on March 20, 1999 and at the Eubie Blake Cultural Center in Baltimore, Maryland on May 19, 1999. (Brooks Aff. ¶ 6, Exs. 2 (fully executed 12/18/98 and 3/2/99 contracts for 3/20/99 and 5/19/99 performances respectively by Opposer (described as “Calloway Brooks”) and “the Cab Calloway Orchestra;” checks paid to musicians dated April 21, 1999 and marked “CCO” for “CAB CALLOWAY ORCHESTRA”); 4 (January 7, 1999 invoice noting CAB CALLOWAY ORCHESTRA); Mikami Decl. ¶¶ 5-6 (noting March 20 and May 19, 1999 Orchestra shows and use of THE CAB CALLOWAY ORCHESTRA in connection with performances); Burton Decl. ¶¶ 3-4 (noting his booking of THE CAB CALLOWAY ORCHESTRA for performance at the Eubie Blake Center, and its May 19, 1999 performance at the Center); Zullo Decl. ¶ 3 (noting his attendance at a 2/99 performance of THE CAB CALLOWAY ORCHESTRA). The Orchestra now performs between twenty-four to forty

¹ In *Creative Arts by Calloway, LLC v. Brooks*, No. 02-7050, 2002 WL 31303241, at *1-2 (2d Cir. Oct. 11, 2002), a copy of which is attached hereto for the Board’s convenience in **Appendix A**, the U.S. Court of Appeals for the Second Circuit noted that Opposer commenced use of THE CAB CALLOWAY ORCHESTRA in 1998, and that between 1999 and 2001 Opposer released two CDs and a video of the Orchestra’s performances.

shows per year throughout the United States (Brooks Aff. ¶¶ 2, 10), and has been described as a “[n]ationally known act,” “world famous,” and “a big time jazz band.” (Opp. Notice, Exs. 3-11.)

3. Opposer’s Use of THE CAB CALLOWAY ORCHESTRA in Connection With Recordings

In addition to his use of THE CAB CALLOWAY ORCHESTRA for his live musical performances, Opposer also uses THE CAB CALLOWAY ORCHESTRA on compact discs and videos sold in the U.S., and has done so continuously from the date of the mark’s adoption. (Stip. of Facts ¶ 5.) Applicant has conceded not only that Opposer sold compact discs and videos under the mark THE CAB CALLOWAY ORCHESTRA, but, more significantly, that he sold compact discs and videos under that mark “prior to Applicant’s July 23, 1999 filing date.” (Opp. Notice, Ex. 12 ¶¶ 9-11.)

Even without Applicant’s concession, Opposer has established without contradiction that he began use of THE CAB CALLOWAY ORCHESTRA in connection with the sale of CDs and videos as early as April 1999. (Brooks Aff. ¶¶ 8-9, Exs. 6 (CD), 7 (3/20/99 invoice for CD mastering, 3/30/99 production memo for video, and 4/15/99-4/22/99 receipts for purchase of CDs), 8 (videotape), 9 (3/9/99 invoice for video editing, 3/30/99 production memo for video, and 4/15/99-4/22/99 receipts for purchase of videos); Mikami Decl. ¶¶ 7-8 (noting sale of CDs and videos branded with THE CAB CALLOWAY ORCHESTRA from 5/19/99 to the present); Burton Decl. ¶¶ 4-5 (noting his 5/19/99 purchase of CD and video branded with THE CAB CALLOWAY ORCHESTRA), Ex. B (5/19/99 receipt for purchase); Zullo Decl. ¶ 5 (noting his 5/22/99 purchase of CD and video branded with THE CAB CALLOWAY ORCHESTRA and his circulation of the same in the entertainment industry), Ex. A (5/22/99 receipt for purchase).)

To date, Opposer has sold approximately 500 copies of his compact disc, and has sold about 300-400 copies of his video. (Brooks Aff. ¶¶ 8-9.) A second compact disc branded with

the mark THE CAB CALLOWAY ORCHESTRA issued in 2001. (*Id.* ¶ 8.)

B. Applicant's Application to Register CAB CALLOWAY

1. The Applicant

Applicant is a Delaware limited liability company founded by its predecessor Zulme Calloway, Cab Calloway's widow, and two of Cab Calloway's daughters. (Stip. of Facts ¶ 6.)

2. The Application at Issue²

On July 23, 1999, Applicant's predecessor filed intent-to-use application Serial No. 75/761,159 to register CAB CALLOWAY. The services in that application are "[r]etail stores, retail outlets and on-line retail store services featuring compact discs, records, video tapes, cassettes, digital video and audio discs, and other home entertainment related products; distribution of pre-recorded comedies, musicals and dramas on video tapes, cassettes, digital video and audio discs, CD-ROM; distribution of pre-recorded theatrical musicals, comedies and dramas on video tapes, cassettes, digital video and audio discs, CD-ROM; and distribution of pre-recorded music, drama, comedy and variety shows on video tapes, cassettes, digital video and audio discs and CD-ROM" in International Class 35, and "[e]ntertainment services in the nature of multimedia entertainment software production services, scheduling of programs on a global computer network; production and distribution of live music concerts, comedy, and dramatic series; production of live music concerts and live theatrical plays; production of radio and television programs; production of videotapes and sound recordings, namely, phonograph records, pre-recorded audio tapes, compact discs, videotapes, digital audio tapes, compact disc videos, and laser discs; production and distribution of motion pictures; production of comedies,

² The file of the Application forms part of the record of this proceeding without any action by the parties, and reference may be made to this file for any relevant and competent purpose. 37 C.F.R. § 2.122(b).

musicals and dramas; scheduling television and radio programming; production of music, drama, comedy and variety shows; theatrical production of musicals, comedies and dramas” in International Class 41. (*Id.* ¶¶ 7-8.) The Application did not and still does not include any claim that the applied-for mark had or has acquired distinctiveness.

In 2001, Applicant’s predecessor filed an amendment alleging use of the mark on “all the goods/services listed in the Application/Notice of Allowance,” and claiming a first use date of January 1, 1928 and a first use in commerce date of January 1, 1929. (2/20/01 Amendment to the Application.) On October 24, 2002, Applicant filed an amended statement of use, again alleging use of the mark on “all the goods/services listed in the Application/Notice of Allowance” except “[r]etail stores, retail outlets and on-line retail services,” and claiming first use and first use in commerce dates of January 1, 1929. (Application, 10/24/02 Amendment.) However, on December 17, 2002 Applicant requested that its amendment to allege use be withdrawn and that the Application proceed to publication in connection with all services exclusively as an intent-to-use application under Section 1(b) of the Lanham Act. (12/17/02 Amendment to Application.) The Application was published for opposition on March 16, 2004. Applicant offers no evidence of use of the applied-for mark.

V. ARGUMENT

A. Opposer Has Standing to Oppose Registration of CAB CALLOWAY

Because the parties have stipulated that THE CAB CALLOWAY ORCHESTRA and Applicant’s applied-for mark CAB CALLOWAY, considered in their entirety, are nearly identical in appearance, sound, connotation, and commercial impression; that Opposer’s orchestral services, CDs, and videos and the services set forth in the Application are identical or closely related; that there is and has been no consent, agreement or assignment between the parties with respect to the use of ownership of their respective marks; and that should Opposer establish that

his rights in THE CAB CALLOWAY ORCHESTRA predate the Application filing date of July 23, 1999, no registration may be granted to Applicant for CAB CALLOWAY for the services set forth in its application, as registration would cause a likelihood of confusion with Opposer's prior-used THE CAB CALLOWAY ORCHESTRA for Opposer's goods and services (Stip. of Facts ¶¶ 11-14), the focus of the parties' arguments is, exclusively, priority.

As the owner and user of the common law mark and trade/business name THE CAB CALLOWAY ORCHESTRA (*see, e.g.*, Stip. of Facts ¶¶ 2-5; Brooks Aff. ¶¶ 5-10), Opposer has standing to challenge the Application. 15 U.S.C. §§ 1052(d), 1063; TBMP § 309.03(b)-(c)(1). Moreover, given the stipulation of the parties acknowledging Opposer's entitlement to relief upon proof of priority, standing clearly is established.

B. Opposer's Rights in THE CAB CALLOWAY ORCHESTRA Pre-Date the July 23, 1999 Application Filing Date

Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), states in relevant part that a trademark shall be refused registration if it "so resembles . . . *a mark or trade name previously used* in the United States by another and not abandoned . . ." (emphasis added).

To establish priority, an Opposer "must show proprietary rights aris[ing] from . . . prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); *see Otto Roth & Co. v. Universal Foods Corp.*, 209 U.S.P.Q. 40, 43 (C.C.P.A. 1981) (must prove "proprietary rights in the term [opposer] relies upon . . . whether by ownership of a registration, prior use of a technical 'trademark,' prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity"); TBMP § 309.03(c)(A). Here, Opposer, prior to the Application filing date, made trademark and service mark use of THE CAB CALLOWAY

ORCHESTRA on and in connection with his musical performances, CDs and videos, used THE CAB CALLOWAY ORCHESTRA in promotional materials, press kits, and advertising, used THE CAB CALLOWAY ORCHESTRA as a trade name, as evidenced by signed contracts relating to the performance of the Orchestra, and otherwise deliberately created a trade identity under the name THE CAB CALLOWAY ORCHESTRA. Applicant offers not one iota of evidence to challenge these facts.

1. Opposer Has Established Prior Use of THE CAB CALLOWAY ORCHESTRA as a Common Law Mark

Rights in a mark generally are acquired through use. 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 16:1 at 16-4 (4th ed. 2008) (hereinafter “*McCarthy*”). An opposer may rely on an unregistered common law mark as the basis for an opposition if the mark is distinctive of his goods. *E.g.*, 15 U.S.C. § 1052(d); *Otto Roth*, 209 U.S.P.Q. 40, 44 & n.2. Where a party has made *bona fide* use of a mark in commerce, *see* 15 U.S.C. § 1145, even a “single use suffices to prove priority if the proponent demonstrates that his subsequent use was ‘deliberate and continuous,’” and “[t]he later filing of an ITU application by another party does not defeat these use-based rights.” *Menashe v. V Secret Catalogue, Inc.*, 409 F. Supp. 2d 412, 424 (S.D.N.Y. 2006) (citation omitted). Here, the evidence shows that Opposer made sufficient use of THE CAB CALLOWAY ORCHESTRA as a common law mark before the Application filing date to establish his prior rights.

a. Opposer Used the Mark THE CAB CALLOWAY ORCHESTRA Prior to the Filing of the Application

Opposer has presented substantial undisputed evidence — including his own sworn testimony and that of three other people, as well as fully-executed contracts, cancelled checks, and a letter from one of the venues where the Orchestra performed — that he used THE CAB

CALLOWAY ORCHESTRA in connection with his Orchestra's live musical performances for at least three different concerts prior to the Application filing date – on December 19, 1998, March 20, 1999, and May 19, 1999 – and made continuous use thereafter. (Brooks Aff. ¶ 6, Exs. 2-4; Mikami Decl. ¶¶ 4-6; Burton Decl. ¶¶ 3-4, Ex. A; Zullo Decl. ¶ 3; *see also* Stip. of Facts ¶ 4 (continuous use from date of adoption).) Opposer also has presented substantial undisputed evidence that he used the mark THE CAB CALLOWAY ORCHESTRA in connection with the sale of audio and video recordings prior to the Application filing date, including between April 15 and April 22, 1999 (Brooks Aff. ¶¶ 8-9, Exs. 6-9; Mikami Decl. ¶¶ 7-8; Burton Decl. ¶¶ 4-5, Ex. B; Zullo Decl. ¶ 5, Ex. A; *see also* Stip. of Facts ¶ 5 (continuous use from date of adoption)), and Applicant has conceded Opposer's prior use for these products. (Opp. Notice, Ex. 12 ¶¶ 9-11.) In addition, Opposer has presented undisputed evidence that he promoted THE CAB CALLOWAY ORCHESTRA by the distribution of a press packet in March 1999 – again, prior to the Application filing date (Zullo Decl. ¶ 4) – and that at the time that packet was distributed, Mr. Brooks had placed his services in the market under the name THE CAB CALLOWAY ORCHESTRA and was soliciting, and receiving, engagements for its performances. It is quite evident that Mr. Brooks began rendering services under the name THE CAB CALLOWAY ORCHESTRA as early as December 1998 and that through his performances, sales of CDs and videos, and distribution of press materials, he made sufficiently public use of THE CAB CALLOWAY ORCHESTRA to identify and distinguish his goods and services to the public.

Based on these undisputed facts, Opposer commenced use of THE CAB CALLOWAY ORCHESTRA prior to the Application filing date, July 23, 1999.

**b. The Mark THE CAB CALLOWAY
ORCHESTRA is Inherently Distinctive**

Having established prior use, to demonstrate prior rights in THE CAB CALLOWAY ORCHESTRA as a common law trademark or service mark Opposer must show that the mark is distinctive in connection with his goods and services. Applicant cannot in good faith challenge the distinctiveness of Opposer's mark, given the position it has taken in connection with its own application for CAB CALLOWAY.

Applicant did not file its application to register CAB CALLOWAY on the basis of acquired distinctiveness. Rather, it proceeded on the assumption that the mark is inherently distinctive. Further, the Patent & Trademark Office allowed the Application to proceed to registration without requiring any evidence of secondary meaning. If, as Applicant contends, CAB CALLOWAY is inherently distinctive for use in connection with its own music-related and entertainment services, how could THE CAB CALLOWAY ORCHESTRA be anything but inherently distinctive when, as conceded by Applicant, it is "nearly identical" to the CAB CALLOWAY mark, and is intended to be used in connection with services "identical or closely related" to Applicant's own services? (Stip. of Facts ¶¶ 11-12.) If both were not inherently distinctive, the Board would be obligated to refuse registration of the Application. *See* TMEP §1212 (if a mark is not inherently distinctive, "it may be registered on the Principal Register only upon proof of acquired distinctiveness").

Even without reliance on the Application, the record demonstrates that THE CAB CALLOWAY ORCHESTRA is not merely descriptive. Based upon Applicant's Notice of Reliance (App. Notice at ¶ 2), it appears that Applicant is attempting to make the untenable argument that somehow Mr. Brooks does not have rights in THE CAB CALLOWAY ORCHESTRA because the mark is a personal name or primarily merely a surname that cannot

be protected absent secondary meaning.³ Applicant's legal theory, previously raised in its brief in opposition to Opposer's earlier motion for summary judgment in this action, is simply wrong.

First, the mark at issue consists in part of the full name, not merely the surname, of Opposer's grandfather, the historical figure Cab Calloway. A mark that incorporates such a full personal name of a recognized artist is inherently distinctive. *See, e.g., Michael S. Sachs, Inc. v. Cordon Art, B.V.*, 56 U.S.P.Q.2d 1132, 1136-37 (T.T.A.B. 2000) ("the name of an artist [M.C. ESCHER] is presumptively not merely descriptive"); *see also In re St. Clair Apparel, Inc.*, Serial No. 75/649,382; 2002 WL 122616, at *3 (T.T.A.B. Jan. 29, 2002) (non-precedential) ("[p]ersonal name marks (so long as they are not primarily merely surnames) are deemed to be inherently distinctive . . ."); *35 Food Corp. v. LFI, Inc.*, Canc. No. 19,494, 2001 WL 901992, at *2 (T.T.A.B. Aug. 9, 2001) (non-precedential) ("[a] personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be inherently distinctive under the Lanham Act"); *Remos v. Feierman*, Opp. No. 114,000, 2001 WL 388787, at *7 (T.T.A.B. Apr. 7, 2001) (non-precedential) ("[a] personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be

³ Specifically, Applicant claims in its Notice of Reliance that three statements from Opposer's memoranda in a prior action between the parties in the federal courts, and which concerned the legal issue of whether Applicant had rights in the name "Cab Calloway," serve as "admission[s] against interest" that "the name of an artist is presumptively a personal name, and that to be protected as a trademark, personal names must have secondary meaning." (App. Notice 2(a)-(c).) As discussed in Section II(C) above, such "evidence" must be disregarded. Even if it were considered, it does not stand for the legal position taken by Applicant. Opposer's prior statements were solely to the effect that the use of the term CAB CALLOWAY by Applicant or its predecessors *to refer to the individual Cab Calloway or his works* did not create protectable rights without a showing of secondary meaning. (See App. Notice, Ex. B (e.g., "[i]f a name, regardless of how famous it is, refers primarily to the individual it is not cannot be protected as a mark").) Opposer, on the other hand, is not using CAB CALLOWAY to refer to Cab Calloway or his works, but as *part* of Opposer's mark THE CAB CALLOWAY ORCHESTRA to refer to the goods and services associated with Opposer's orchestra.

inherently distinctive under the Lanham Act. . . . We see no logical basis for holding that a personal name mark which is inherently distinctive for registration purposes must nonetheless be shown to have acquired secondary meaning before it can be relied upon by an opposer in an opposition proceeding”).⁴

Second, the CAB CALLOWAY portion of Opposer’s mark is not the name of Opposer or a living person, and it does not describe Opposer or Opposer’s goods or services. Rather, it is a historical name. “Historical names that are widely recognized as such do not really fall into the classical ‘personal name’ category at all,” and “do not suffer from the lack of inherent distinctiveness that is the basis for requiring proof of secondary meaning.” 2 *McCarthy* § 13:25 at 13-42-43. Similarly, the *Restatement (Third) of Unfair Competition* § 14, comment *e* (1995), states that “[i]f a mark consists of the name of an historical figure or other noted person and is likely to be recognized as such by prospective purchasers, secondary meaning ordinarily will not be required.” *See also, e.g., Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 165 U.S.P.Q. 459, 461 (S.D.N.Y. 1970) (DA VINCI not merely a surname). Here, Applicant readily has conceded that Cab Calloway is a historical figure and noted person in American music. (Opp. Notice, Ex. 13, at ¶¶ 2-7 (noting Cab Calloway’s extraordinary fame, and describing him as “international jazz icon”).) It is in this context that Opposer is using the name, and consumers readily will recognize this use of CAB CALLOWAY by Opposer in his full mark.

Third, even if the CAB CALLOWAY portion of Opposer’s mark improperly were considered to be merely descriptive, Opposer’s composite mark THE CAB CALLOWAY ORCHESTRA, which must be considered as a whole, *see, e.g., 2 McCarthy* § 11.27 at 11-69

⁴ For the Board’s convenience, copies of the non-precedential cases cited above, which “may be cited for whatever persuasive value [they] might have” (USPTO 1/23/07 Official Gazette Notice), are provided herewith in **Appendix A**.

(“a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts”), is not descriptive. The mark in its entirety is THE CAB CALLOWAY ORCHESTRA, which includes the full name of a deceased historical person, Opposer’s grandfather, and ORCHESTRA. Opposer uses this mark for a jazz band that performs songs written and recorded not just by Cab Calloway, but by a number of other artists, including Opposer. (Brooks Aff. ¶ 5.) The mark is not descriptive as it does not merely describe Opposer (who is not named Cab Calloway), his band (which does not include Cab Calloway), or the music of that band (which is not limited to the music of Cab Calloway). Rather, consumers will understand that THE CAB CALLOWAY ORCHESTRA suggests a “legacy band” that plays various music *as a tribute to* Opposer’s grandfather Cab Calloway, as well as goods and services (such as recordings) associated with that band.⁵ As such, the mark THE CAB CALLOWAY ORCHESTRA became protectable as a mark as of its adoption in December, 1998.

2. Opposer Has Established Prior Proprietary Use of THE CAB CALLOWAY ORCHESTRA

A separate basis for granting Opposer relief is his use of THE CAB CALLOWAY ORCHESTRA as a business/trade name, and in a manner analogous to trademark and service mark use, prior to Applicant’s July 23, 1999 Application filing date. Indeed, even if the Board were to find that Opposer had not established common law trademark or service mark rights in THE CAB CALLOWAY ORCHESTRA prior to July 1999, it must still enter judgment for Mr. Brooks based on his establishment of trade name rights. *E.g., West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 U.S.P.Q.2d 1660, 1665 (Fed. Cir. 1994).

⁵ In this regard, THE CAB CALLOWAY ORCHESTRA is similar to such recognized and registered marks as COUNT BASIE ORCHESTRA, Reg. No. 2,459,428, and TOMMY DORSEY ORCHESTRA, Reg. No. 2,438,337, both used for legacy orchestras, and both registered without requiring any proof of secondary meaning. (*See* Opp. Notice, Ex. 14-15.)

To establish priority an Opposer need only show “proprietary rights” which may arise from “prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko*, 64 U.S.P.Q.2d at 1378; *see Otto Roth*, 209 U.S.P.Q. at 43; TMBP § 309.03(c)(A); *see also 3 McCarthy* § 20:16 at 20-45 (“[t]he effect of § 2(d) may sometimes be that an opposer can prevent registration of a mark even though the opposer itself is not entitled to federal registration because it has never used the term as an affixed ‘trademark’”).

A “trade name” is “any name used by a person to identify his or her business or vocation.” 15 U.S.C. § 1127 (def. of “trade name”). As the Federal Circuit has observed,

[n]othing more than trade name use is required to bar the registration of a mark. . . . To establish trade name use, an organization need only to have used a name. . . . in a manner that identifies the company by that name. . . . to the public. . . . no particular formality of adoption or display is necessary to establish trade name identification.

West Florida Seafood, 31 U.S.P.Q.2d at 1665 (citations and internal quotation marks omitted); *see also L. & J.G. Stickley, Inc. v. Cosser*, 81 U.S.P.Q.2d 1956, 1968 (T.T.A.B. 2007) (“a trade name lacking any independent trademark or service mark significance may bar registration of a trademark or service mark that is confusingly similar to that trade name”) (citation omitted); 3 *McCarthy* § 20.16 at 20-40 (“an opposer’s use of a corporate title or business name as a trade name (not as a trademark) is a proper ground for opposition to the registration of a similar term as a trademark or service mark”). Here, Opposer’s undisputed evidence shows that he used THE CAB CALLOWAY ORCHESTRA to identify his business to the public prior to the filing of Applicant’s application, and has continued to do so.

As early as September 25, 1998, Opposer entered into contracts for the provision of his Orchestra’s services. (Brooks Aff. ¶¶ 6, Ex. 2 (9/25/98, 12/18/98, and 3/2/99 contracts between

venues and “Christopher Brooks and the Cab Calloway Orchestra” or “Calloway Brooks and the Cab Calloway Orchestra.”) The March 9, 1999 bill for video editing and March 20, 1999 bill for CD editing and mastering, both of which were addressed to “Chris Brooks, Cab Calloway Orchestra” (Brooks Aff. ¶¶ 8-9, Exs. 7, 9) also show that Opposer was identifying his company to the public by that name prior to the filing date of the Application, and that the public was using the name THE CAB CALLOWAY ORCHESTRA to identify and refer to Opposer and his business. This trade name/business name use has continued uninterrupted since 1998 (e.g., Stip. of Facts ¶¶ 3-5; Brooks Aff. ¶¶ 6, 10), and in itself creates sufficient rights to bar Applicant’s registration of the applied-for mark. *West Florida Seafood*, 31 F.3d at 1128.

Priority also may arise from “prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko*, 64 U.S.P.Q.2d at 1378. Use analogous to trademark use

is non-technical use of a trademark in connection with the promotion or sale of a product under circumstances which do not provide a basis for an application to register, usually because the statutory requirement for use on or in connection with the sale of goods in commerce has not been met. Although never considered an appropriate basis for an application to register, such use has consistently been held sufficient use to establish priority rights as against subsequent users of the same or similar marks.

Shalom Children’s Wear Inc. v. In-Wear A/S, 26 U.S.P.Q.2d 1516, 1519 (T.T.A.B. 1993) (citations omitted); *see also L. & J.G. Stickley*, 81 U.S.P.Q.2d at 1968 (party may rely upon advertising/promotional use of a term or expression to defeat right of registration asserted by another who made subsequent trademark use of that term or expression on same or similar goods).

Here, Opposer made such use of THE CAB CALLOWAY ORCHESTRA in connection with the advertising and promotion of his goods and services prior to the filing date

of the Application. As noted by declarant Monty Zullo, a promotional consultant, in March 1999 Opposer created a press packet advertising and promoting Opposer's band under the name THE CAB CALLOWAY ORCHESTRA, which Mr. Zullo distributed to various industry contacts. (Zullo Decl. ¶ 4.) Moreover, the distribution and sale of Plaintiff's CD and video, which unquestionably took place prior to Applicant's filing of the Application (*see* (1)(a) *supra*), not only promoted the CDs and videos themselves but also promoted the band's performances under the name THE CAB CALLOWAY ORCHESTRA. (*See* Brooks Aff. ¶¶ 8-9, Exs. 6 (CD), 8 (video).) Again, this use is in itself enough to establish Opposer's prior rights and bar Applicant's registration of the mark set forth in its Application. *Herbko*, 64 U.S.P.Q.2d at 1378; *Otto Roth*, 209 U.S.P.Q. at 43; *L. & J.G. Stickley*, 81 U.S.P.Q.2d at 1968; TMBP § 309.03(c)(A).

VI. SUMMARY

The issue in this case is simple. Did Opposer use THE CAB CALLOWAY ORCHESTRA as a trademark/service mark, or as a trade name, or in a manner analogous to trademark/service mark use before July 23, 1999? The facts and evidence relating to this single issue are undisputed. As early as September 1998, Opposer was entering into contracts under the name THE CAB CALLOWAY ORCHESTRA. By no later than December 1998, Opposer was performing under the name THE CAB CALLOWAY ORCHESTRA. By no later than March 1999, Opposer was distributing or having distributed on his behalf press releases identifying his company, his business, and his band as THE CAB CALLOWAY ORCHESTRA. By no later than April 1999, Opposer was offering for sale and selling CDs and videos under the name THE CAB CALLOWAY ORCHESTRA. All of these activities have continued unabated. Opposer deliberately, consistently, and continuously held himself out to the public as THE CAB CALLOWAY ORCHESTRA and was recognized as such, before the filing of the Application.

(Indeed, in his tax returns for the tax year 1998, Opposer identified his profit and/or loss for THE CAB CALLOWAY ORCHESTRA.)

This is not a case where the use of a name or mark is questionable, sporadic, or otherwise not made in good faith. Opposer's priority is clearly established, and Applicant can raise no issues with the evidence, the facts, or the law to change the conclusion that Opposer has prior rights in THE CAB CALLOWAY ORCHESTRA, and that, pursuant to the stipulation entered by the parties, Opposer is entitled to judgment in his favor in this Opposition.

VII. CONCLUSION

For the reasons set forth above, Opposer respectfully requests that the Board sustain the Opposition and refuse registration of Application Serial No. 75/761,159 for Applicant's mark CAB CALLOWAY under Section 2(d) of the Lanham Act.

Dated: New York, New York
January 16, 2009

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.



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APPENDIX A

Westlaw.

48 Fed.Appx. 16
 48 Fed.Appx. 16, 2002 WL 31303241 (C.A.2 (N.Y.))
 (Not Selected for publication in the Federal Reporter)
 (Cite as: 48 Fed.Appx. 16, 2002 WL 31303241 (C.A.2 (N.Y.)))

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C

This case was not selected for publication in the Federal Reporter.

United States Court of Appeals, Second Circuit.
 CREATIVE ARTS BY CALLOWAY, L.L.C., d/b/a
 C.A.B. Calloway, L.L.C., Plaintiff-Appellant,
 v.

Christopher BROOKS, d/b/a The Cab Calloway Or-
 chestra, Defendant-Appellee.
No. 02-7050.

Oct. 11, 2002.

Marc A. Karlin, Karlin & Karlin, Los Angeles,
 California, for Plaintiff-Appellant.
 Barbara A. Solomon, Fross, Zelnick, Lehrman &
 Zissu, New York, New York, for Defendant-Appellee.

Present JACOBS and POOLER, Circuit Judges, and
 BAER, District Judge.^{FN*}

FN* The Honorable Harold Baer, Jr.,
 United States District Judge for the South-
 ern District of New York, sitting by design-
 ation.

SUMMARY ORDER

****1** Appeal from judgment of the United States District Court for the Southern District of New York (Charles L. Bricant, Judge) granting Defendant's motion for summary judgment and denying Plaintiff's motion for a preliminary injunction.

***17 ON CONSIDERATION WHEREOF, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED** that the judgment of the District Court be and it hereby is **AFFIRMED**.

This trademark infringement action arises out of Defendant-Appellee Christopher Brooks' use of the

name "Cab Calloway." Cab Calloway, born Cabell Calloway III on December 25, 1907, was a jazz musician who performed solo, with a small ensemble under the name "Cab Calloway and The Cab Jivers," and with big bands under the names "Cab Calloway and The Hi De Ho Orchestra," "Cab Calloway and His Famous Orchestra," and "Cab Calloway and The Cotton Club Orchestra." Cab Calloway died November 18, 1994 and was survived by his widow, Zulme Calloway, and several children and grandchildren, including Brooks, his oldest grandson from an earlier marriage.

Both Zulme Calloway and Brooks have sought to preserve the musical legacy of Cab Calloway. In 1998, Brooks formed "The Cab Calloway Orchestra," which plays vintage Cab Calloway songs using the original arrangements. Brooks also performs with smaller ensembles, titled "The Cab Calloway Band," "The Cab Calloway Duo (or Trio)," or "Calloway Brooks and The Cab Jivers." Brooks, who sometimes uses the stage names "Calloway Brooks" or "Christopher Calloway Brooks," has performed over 150 concerts and, between 1999 and 2001, released two compact discs and a video tape of his performances.

Zulme Calloway and several other relatives formed Creative Arts by Calloway, L.L.C. ("Creative Arts") on December 25, 2000. The Calloway family created Creative Arts to manage the rights associated with Cab Calloway's name, likeness, voice, and intellectual property. Creative Arts maintains that Cab Calloway's will transferred his trademark rights in the name "Cab Calloway" to Zulme Calloway, who subsequently transferred them to Plaintiff-Appellant.

On April 16, 2001, Creative Arts filed suit against Brooks, alleging that his use of the name "Cab Calloway" constitutes: 1) common law service mark infringement; 2) unfair competition in violation of the Lanham Act, 15 U.S.C. § 1125(a); 3) service mark dilution in violation of New York General

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Business Law §§ 368-c, d; and 4) unfair business practices in violation of New York General Business Law §§ 349, 350. Creative Arts also sought a preliminary injunction to prohibit Brooks from doing business as "The Cab Calloway Orchestra." The district court granted Brooks summary judgment on Creative Arts' claims in their entirety, and denied Creative Arts' motion for a preliminary injunction, on the grounds that: 1) there is no evidence that Cab Calloway had a common law service mark in his name, as there is no evidence that the name ever acquired secondary meaning; 2) assuming Cab Calloway had such a mark, he did not transfer it in conjunction with an ongoing business, rendering any assignment invalid; and 3) Brooks' use of the name "Cab Calloway" is protected as fair use. Creative Arts appeals the district court's judgment.

****2** Regardless of whether the name "Cab Calloway" acquired secondary meaning during the performer's lifetime, Creative Arts cannot prevail because any trademark assignment to Zulme Calloway would have been invalid. A trademark is merely a symbol of goodwill and cannot be sold or assigned apart from the goodwill it symbolizes. *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir.1984) (citing Lanham Act, § 10, 15 U.S.C.S. § 1060). As goodwill is inseparable from the underlying business with which it is associated, rights in a trademark cannot be transferred "in gross," or apart from an ongoing business. ***18** See *id.* ("There are no rights in a trademark apart from the business with which the mark has been associated; they are inseparable."). See also *Berni v. International Gourmet Restaurant, Inc.*, 838 F.2d 642, 646-47 (2d Cir.1988). Moreover, the assignee must continue to offer products or services that are "substantially similar" to those of the assignor. *Marshak*, 746 F.2d at 930. See also *Visa U.S.A., Inc. v. Birmingham Trust Nat. Bank*, 696 F.2d 1371, 1376 (Fed.Cir.1982) ("[T]he transfer of goodwill requires only that the services be sufficiently similar to prevent consumers of the service offered under the mark from being misled from established associ-

ations with the mark.") (internal quotation marks omitted).

In the instant case, Cab Calloway was not operating a going concern at the time of his death, precluding the transfer of a mark. Creative Arts argues that Cab Calloway was in the business of marketing his entertainment services. "Entertainment" may be considered a service in connection with the law of service marks. See *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir.1981) (citations omitted); *Estate of Presley v. Russen*, 513 F.Supp. 1339, 1363 n. 31 (D.N.J.1981) (citations omitted). However, Cab Calloway's activities were not organized as a business that could have been transferred to his widow.

Creative Arts argues that Cab Calloway transferred his entertainment business to Zulme Calloway, because retailers continue to sell his music and audiences can watch his television and movie appearances. However, it is undisputed that various record companies own the rights to the masters of Cab Calloway's songs, and there is no evidence that Creative Arts owns the rights to any of Cab Calloway's public appearances.

The Court has considered Creative Arts' remaining arguments on this issue and finds them to be without merit. As there is no evidence that Cab Calloway operated a going concern at the time of his death, the Court need not reach the issue whether Brooks' use of the name "Cab Calloway" constitutes fair use. We note, however, that it is doubtful Brooks' naming of his orchestra would fall within this Court's jurisprudential definition of fair use, as he apparently is using the name "Cab Calloway" as part of his own trademark, "The Cab Calloway Orchestra." See *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 30 (2d Cir.1997) ("The defense [of fair use] permits others to use protected marks in descriptive ways, but not as marks identifying their own products.") (citing *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir.1995)).

C.A.2 (N.Y.),2002.

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Creative Arts by Calloway, L.L.C. v. Brooks
48 Fed.Appx. 16, 2002 WL 31303241 (C.A.2 (N.Y.))

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2002 WL 122616 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board
 Patent and Trademark Office (P.T.O.)

IN RE ST. CLAIR APPAREL, INC.

Serial No. 75/649,382

January 29, 2002

Susan B. Flohr of Blank Rome Comisky & McCauley for St. Clair Apparel, Inc.

Nora Buchanan Will
 Trademark Examining Attorney
 Law Office 101
 (Jerry Price, Managing Attorney).

Before Quinn, Bottorff and Rogers
 Administrative Trademark Judges.
 Opinion by Bottorff
 Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark ST. CLAIR APPAREL, in typed form, for goods identified in the application as "men's, women's and children's clothing, namely, tops, sport shirts, T-shirts."^(FN1) Applicant has disclaimed the exclusive right to use APPAREL apart from the mark as shown.

The Trademark Examining Attorney issued three refusals of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to applicant's goods, is confusingly similar to three registrations owned by three different registrants: the mark CARLY ST. CLAIRE, registered in typed form for "clothing, namely, sweaters";^(FN2) the mark MARIE ST. CLAIRE, registered in typed form for "women's clothing, namely, dresses";^(FN3) and the mark NINA ST. CLAIRE, registered in stylized form for "women's clothing, namely, skirts, pants, shorts, culottes, jackets, vests, jumpsuits, blouses, shirts, tops, belts and scarves."^(FN4)

When the refusals were made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney filed main briefs, and applicant filed a reply brief. No oral hearing was requested. We affirm each of the refusals of registration.

The only evidence of record on appeal are the six third-party registrations the Trademark Examining Attorney attached to her final refusal.^(FNS) Those registrations, all of which cover clothing items, are of the marks CLAIBORNE and LIZ CLAIBORNE (both of which are owned by a single registrant), LAUREN and RALPH LAUREN (both of which are owned by a single registrant), and ADRIENNE VITTADINI and VITTADINI SPORT (both of which are owned by a single registrant). The Trademark Examining Attorney offered this evidence in support of her contention that, in the apparel industry, it is common for a company to market its clothing products under the name of an individual, and for such a company to use both a trademark consisting of the individual's surname as well as a trademark consisting of the individual's full name.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

*2 Based on the identifications of goods in the application and in the three cited registrations, we find that applicant's goods are legally identical to certain of the goods identified in the NINA ST. CLAIRE registration (i.e., "blouses, shirts, tops") and closely related to the remainder of the goods identified in that registration, and that they are closely related to the goods identified in the CARLY ST. CLAIRE and MARIE ST. CLAIRE registrations. Furthermore, given this close relationship between the respective goods, and in view of the absence of any restrictions in the respective identifications of goods, we find that applicant's goods and the goods identified in each of the cited registrations are marketed in the same or highly similar trade channels, and to the same or highly similar classes of purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). These *du Pont* factors weigh in favor of a likelihood of confusion finding in this case. Applicant does not contend otherwise.

We turn next to a determination of whether applicant's mark and each of the cited registered marks, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be con-

sidered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on legally identical and/or closely related goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

Initially, we find that the designation ST. CLAIR is the dominant feature of applicant's mark, and that it therefore is the feature which is entitled to the greatest weight when we compare applicant's mark to the cited registered marks. In making those comparisons, we do not disregard the presence of the disclaimed, generic word APPAREL in applicant's mark, but we find that it contributes relatively little to the mark's commercial impression, and we therefore have accorded it relatively less weight in our analysis of the marks. See *In re National Data Corp.*, *supra*.

*3 In terms of appearance and sound, we find that applicant's mark is essentially identical to each of the cited registered marks to the extent that it, and they, include the designation ST. CLAIR or ST. CLAIRE. We find that the difference in spelling between ST. CLAIR and ST. CLAIRE is inconsequential, and that the marks are legal equivalents in terms of appearance and sound to the extent that they each include ST. CLAIR or ST. CLAIRE. Applicant's mark and the registered marks obviously differ in terms of appearance and sound to the extent that applicant's mark contains the generic word APPAREL while the registered marks do not, and to the extent that the registered marks each include a first name, while applicant's mark does not. However, viewing the marks in their entirety, we find that the similarity in appearance and sound resulting from the presence in each mark of the term ST. CLAIR or ST. CLAIRE outweighs the dissimilarities which result from the presence or absence of the other words in the respective marks.

In terms of connotation, we find that applicant's mark is similar to each of the cited registered marks in that each of the marks connotes the name of a person named ST. CLAIR or ST. CLAIRE. The presence in applicant's mark of the generic word APPAREL does not negate or detract from that connotation. Applicant argues that its mark would be perceived as connoting apparel originating from a geographic place called ST. CLAIR, a connotation not shared by any of the cited registered marks. However, there is no evidence in the record that such a place exists, or that, if it does exist, that it is anything more than a remote or obscure place.^(FNG) We cannot conclude that any such geographic significance of ST. CLAIR suffices to negate the obvious surname significance and connotation of the term, or that purchasers viewing applicant's mark necessarily would see it only as a geographic term and be able to distinguish it from any of the cited registered marks on that basis. We find that applicant's mark, viewed in its entirety, has a connotation which is similar to the connotation of each of the cited registered

marks.

In view of the Trademark Examining Attorney's evidence that clothing companies often use personal name marks, and that those marks can be either the surname alone or a full name (first name and last name), we find that purchasers familiar with any of the cited registered marks would be likely to mistakenly assume, upon encountering applicant's mark used on the same or closely related goods, that a source connection exists. Applicant's mark is confusingly similar to each of the registered marks, and each of those previous registrations bars issuance of the registration that applicant seeks.

Applicant argues that the designation ST. CLAIRE in the registered marks is a descriptive or otherwise weak term, such that the minor points of distinction between applicant's mark and the cited registered marks suffice to eliminate any likelihood of source confusion. We are not persuaded. Contrary to applicant's contention, none of the registered marks is merely descriptive by virtue of its being a personal name. Personal name marks (so long as they are not primarily merely surnames) are deemed to be inherently distinctive and are registrable on the Principal Register without resort to the acquired distinctiveness provisions of Section 2(f).^(FN7) Accordingly, we reject as inapposite the cases applicant cites for the proposition that merely descriptive marks are to be accorded a narrow scope of protection. Equally inapposite are the cases cited by applicant for the proposition that registrations can be used in the manner of dictionaries as evidence of the meaning of the terms appearing in the registered marks. Applicant has not specified, and we cannot discern, how the presence of ST. CLAIRE in the three cited registrations constitutes evidence of what ST. CLAIRE means, or how that revealed meaning of the term affects this case. Finally, we find that *Taj Mahal Enterprises, Ltd. v. Trump*, 15 USPQ2d 1641 (DC NJ 1990), in which the court found that the mark TAJ MAHAL for restaurants was weak and diluted based on evidence that there were twenty-four third parties using the term in connection with restaurants, is so readily distinguishable from the present case (which involves three registered marks) that it is of no persuasive value as authority here.

*4 We likewise are not persuaded by applicant's argument that if the three cited registered marks can co-exist in the marketplace and on the register, applicant's mark can co-exist as well. Rather, we find that the three registered marks are readily distinguishable from each other, inasmuch as each of them would be perceived as connoting or referring to a different person, each with a readily distinguishable first name. Applicant's mark, in contrast, does not readily or necessarily connote an additional or different person. Instead, it connotes a person with the surname ST. CLAIR, who, given the industry practice of using both surnames alone and full names as marks, could readily be perceived to be the NINA ST. CLAIRE, or CARLY ST. CLAIRE, or MARIE ST. CLAIRE who is identified in the respective registered marks.

In summary, we have considered all of the evidence properly made of record with

respect to the *du Pont* evidentiary factors, and we conclude that a likelihood of confusion exists as between applicant's mark and each of the three cited registered marks.

Decision: Each of the Section 2(d) refusals is affirmed.

FN1. Serial No. 75/649,382, filed March 2, 1999. The application is based on use in commerce, and December 1998 is alleged as the date of first use of the mark and first use of the mark in commerce.

FN2. Registration No. 2,029,041, issued January 1, 1997, owned by Tiara International, Inc.

FN3. Registration No. 1,797,894, issued October 12, 1993 (Section 8 and 15 affidavits accepted and acknowledged), owned by LCEL Collectibles, Inc.

FN4. Registration No. 1,642,124, issued September 11, 1990 (Section 8 and 15 affidavits accepted and acknowledged), owned by Teddi of California.

FN5. We note that applicant submitted numerous evidentiary materials with its reply brief. These materials were not previously made of record prior to the filing of the appeal. Accordingly, we have not considered them, nor applicant's arguments based thereupon. See Trademark Rule 2.142(d).

FN6. We note that, according to the application, applicant is located in South Bend, Indiana.

FN7. Indeed, the three registrations cited by the Trademark Examining Attorney in this case each issued on the Principal Register, and two of them are now incontestable. To the extent that applicant, by calling the registered marks merely descriptive, is challenging the validity of the registrations, such challenge is without legal or procedural basis in this ex parte proceeding.

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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

35 FOOD CORP.

v.

LFI, INC.

Cancellation No. 19,494

August 9, 2001

Before Cissel, Hohein and Holtzman
Administrative Trademark Judges.

By the Board:

This case now comes before the Board for consideration of petitioner's motion (filed December 22, 1997) and respondent's cross-motion (filed October 17, 2000) for partial summary judgment on the issue of priority of use. The motions have been fully briefed.

BACKGROUND/PLEADINGS

In the petition to cancel, petitioner alleges that petitioner has used the mark and trade name "ANTONIO'S and variations thereof," prior to any date respondent may claim with regard to its mark ANTONIO. In its answer, respondent has admitted that the parties' marks are similar, but has denied allegations that the parties' goods are related and that the parties distribute and sell their respective goods through the same channels of trade.

During the course of this proceeding, respondent's registration was cancelled under Section 8 of the Trademark Act. On June 12, 1997, the Board found that respondent's failure to file the Section 8 affidavit was inadvertent and, on July 14, 1997, petitioner elected to go forward with this proceeding. On October 16, 1998, the Board limited the scope of petitioner's summary judgment motion to the issue of prior use.

SUMMARY JUDGMENT STANDARD

The granting of a motion for summary judgment is appropriate where there exists no genuine issue as to any material fact and where the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The nonmoving party must

be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

THE PARTIES' EVIDENCE AND ARGUMENTS

In support of its motion and in opposition to respondent's motion, petitioner has submitted the declarations of: Mario Catillo, a shareholder and owner of petitioner's predecessor, with accompanying exhibits consisting of invoices from 1979 displaying the name ANTONIO'S FOOD WHOLESALERS; Richard Winant, petitioner's owner and vice president, with accompanying exhibits consisting of photographs of the original stamps for product labeling displaying, inter alia, the mark ANTONIO'S, invoices from 1995-1996 displaying the mark ANTONIO'S, product labels displaying the mark ANTONIO'S, the bill of sale of the business from petitioner's predecessor to petitioner, excerpts from Mr. Winant's discovery deposition and additional invoices from 1979 depicting the name ANTONIO'S FOOD WHOLESALERS; and Michelle Winant, an employee of both petitioner and petitioner's predecessor.

*2 In opposition to petitioner's motion and in support of its own motion, respondent has submitted the declaration of: Mr. Tony Lisanti, respondent's president, with accompanying exhibits consisting of invoices from 1980-1996 displaying the mark ANTONIO and excerpts from trade show promotional materials displaying the mark ANTONIO; the declaration of Peter Nussbaum, respondent's attorney, with accompanying exhibits consisting of a print-out of petitioner's application for registration of the mark ANTONIO'S, and excerpts from the 1977-78 Brooklyn, New York telephone directory.^[FN1]

Petitioner states that it has used the trade name and mark ANTONIO'S and variations thereof since 1973. This statement is supported by declarations and documentary evidence. Although respondent asserts that petitioner's "evidence is suspect," this claim is unsupported and respondent has not submitted anything to refute petitioner's evidence of prior use.

Respondent states that it has used the mark ANTONIO since 1980 and supports this statement with documentary evidence dating back to 1980. Respondent argues that the parties' personal name marks are not inherently distinctive and that respondent has priority by being the first to acquire distinctiveness. Further, respondent argues that petitioner "has not established that its mark has been used in interstate commerce."

DECISION

To establish priority under Section 2(d), a party must prove that, vi-a-vis the other party, it owns "a mark or trade name previously used in the United

States...and not abandoned..." 15 U.S.C. Section 1052.^[FN2]

As a preliminary matter, we address respondent's argument that personal names are subject to the requirement to show acquired distinctiveness.

We note, first, that respondent did not plead this affirmative defense and a party may not obtain summary judgment on an issue which has not been pleaded. See TBMP 528.07(a) and cases cited therein. However, even if we were to consider it, respondent's argument is not well taken. While respondent has cited various authorities in support of the proposition that personal name marks, such as its own and petitioner's, are merely descriptive and not entitled to protection absent a showing of secondary meaning, respondent has not cited to any prior decisions of the Board or of its primary reviewing court in which this proposition has been stated or followed, and we are aware of no such decisions. For the reasons discussed below, we are not persuaded that we should follow the authorities cited by respondent on this issue.

A personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be inherently distinctive under the Lanham Act. Indeed, respondent's own mark, ANTONIO, was not refused registration as merely descriptive, and was registered by the Office without any requirement for a showing of acquired distinctiveness. We see no logical basis for holding that a personal name mark which is inherently distinctive for registration purposes must nonetheless be shown to have acquired distinctiveness before it can be relied upon by a petitioner in a cancellation proceeding. Thus, we reject respondent's argument regarding petitioner's alleged failure to establish acquired distinctiveness in his mark.

***3** With regard to respondent's argument that petitioner has not used the mark in interstate commerce, intrastate use is sufficient to establish priority. *Odom Sausage Co. v. Daskocil Sausage, Inc.*, 169 USPQ 379, (TTAB 1971); *Zimmerman v. Holiday Inns of America, Inc.*, 123 USPQ 86 (TTAB 1959); *Corporate Document Services, Inc. v. I.C.E.D. Management, Inc.*, 48 USPQ2d 1477 (TTAB 1998).

Turning now to the question of first chronological use, inasmuch as petitioner has demonstrated prior use through unrefuted evidence, we find that there is no genuine issue of material fact regarding petitioner's prior use. The record shows that petitioner, through its predecessor, is the prior user of the trade name and mark ANTONIO'S and variations thereof. Accordingly, petitioner's motion for partial summary judgment is granted and respondent's cross-motion is denied.^[FN3] This case will now go forward on the remaining issue of likelihood of confusion.^[FN4]

Trial dates are reset as indicated below.

30-day testimony period for party in position of plaintiff to close:	11/5/01
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30-day testimony period for party in position of defendant to close: 1/4/02

15-day rebuttal testimony period for plaintiff to close: 2/18/02

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within 30 days after completion of the taking of testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

FN1. The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

FN2. The question of priority is an issue in this case because petitioner does not own an existing registration upon which it can rely under Section 2(d). Distinguish, e.g., *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Nor may respondent rely on its cancelled registration.

FN3. The parties are advised that our decision granting partial summary judgment is interlocutory in nature. The time for seeking judicial review thereof shall expire two months from the date of a final decision in this cancellation proceeding. See Trademark Rule 2.145(d); and *Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1988). See also, TBMP Section 901.02.

FN4. As noted above, the similarity of the marks has already been conceded in the answer.

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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

ARIEL REMOS

v.

ARIEL FEIERMAN

Opposition No. 114,000

April 17, 2001

Before Quinn, Hairston and Bottorff
Administrative Trademark Judges.
Opinion by Bottorff
Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark ARIEL, in typed form, for services recited in the application as "entertainment services, namely, live performances rendered by a musical group."^(FN1) Opposer filed a timely notice of opposition to registration of applicant's mark, alleging that opposer is the prior user of the mark ARIEL in connection with musical entertainment services and that applicant's use of her mark in connection with her recited services is likely to cause confusion. See Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant filed an answer by which she denied the allegations of the notice of opposition which are essential to opposer's claim.

This case now comes up on the parties' cross-motions for summary judgment as to opposer's Section 2(d) claim. The motions have been fully briefed.^(FN2) The evidence of record on summary judgment includes: the file of the opposed application; the pleadings; the two declarations of opposer Ariel Remos and the exhibits attached thereto; the declaration of opposer's witness Cliff Walker and the exhibits attached thereto; the declaration of applicant Ariel Feierman and the exhibits attached thereto; the declaration of applicant's witness Robert Torsello and the exhibits attached thereto; and the two declarations of applicant's counsel Lana Fleishman and the exhibits attached thereto. Applicant has objected to certain of opposer's documentary exhibits; those objections will be discussed *infra*.

We have carefully considered all of the parties' arguments and all of the evidence properly made of record, including any arguments or evidence not specifically dis-

cussed in this opinion. For the reasons discussed below, we grant opposer's motion for summary judgment and deny applicant's cross-motion for summary judgment. See Fed. R. Civ. P. 56(c).

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id.* When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

*2 There is no genuine issue of material fact that opposer is the owner of application Serial No. 75/477,155, by which he seeks registration of the mark ARIEL for "entertainment in the nature of a live or recorded performing musical group," or that applicant's prior-filed application has been cited against opposer's application as a potential Section 2(d) bar to registration of opposer's mark. In view thereof, we find that opposer has standing to oppose registration of applicant's mark in this proceeding. See *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990).

We turn next to the question of priority, which is an issue in this case because opposer does not own an existing registration upon which he can rely under Section 2(d). *Distinguish, e.g., King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To establish his priority under Section 2(d), opposer must prove that, vis-à-vis applicant, he owns "a mark or trade name previously used in the United States... and not abandoned..."

There is no dispute that the date of applicant's first use of her mark, and the earliest date upon which she can rely for purposes of priority, is January 14,

1996. Accordingly, opposer's Section 2(d) priority claim requires proof that opposer owns a mark or trade name used in the United States prior to January 14, 1996 and not abandoned.

In his first summary judgment declaration, opposer Ariel Remos avers as follows, in pertinent part:

1. My name is Ariel Remos and I am the leader of a four person club band called "Ariel." I sing lead vocals, play keyboard and drums and write, arrange and produce all our original songs.
2. I began to use the mark "Ariel" for the band on December 12, 1981.
3. The band originally began playing in South Florida nightclubs and in festivals throughout the southeast. We now play throughout the country, in the Caribbean and in Central America. The band has been featured on "CBS This Morning" and on the Univision and Telemundo Spanish Television Networks. I have continued to use the mark "Ariel" throughout the United States for the band since 1981. In addition, I am creating a Web site under the name "ariel-band.com" to market the band on the Internet. I currently use it and have never abandoned it.
4. We have recently finished our first album in both Spanish and English which will be distributed worldwide under the "Ariel" mark.
5. On January 8, 1991 I registered the trademark "Ariel" for Entertainment Services in the nature of a musical group.
6. My registration was cancelled on July 14, 1997 for failure to file a Section 8 Affidavit.
7. I applied to reregister the mark on April 30, 1998.
8. I first learned of Applicant's use of the mark "Ariel" when its application was cited against mine on February 1, 1999.

*3 In his second summary judgment declaration, submitted with his response to applicant's cross-motion for summary judgment, opposer Ariel Remos avers as follows, in pertinent part:

1. My name is Ariel Remos and I am the leader of a four-person club band called "Ariel." The band's name encompasses and refers to all the members of the band. It has also become associated with the type of high energy performing we do. As the band's leader I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself.
2. In addition, the band has several booking agents who book the band and also handle advertising and promotion of the band always under the "Ariel" mark. These include Walker Entertainment, Fantasma, Deco Productions, Southern Nights, Adam Productions, and Vega (Louisiana) (See Declaration of Cliff Walker).
3. Since 1981, I estimate that we have spent approximately \$5,000.00 per year on advertising and promotion of the band under the trademark "Ariel." Unfortunately, I have not saved copies of many of the materials that have accompanied

our performances over the years or retained many old records. It has consisted in the past and now consists of yellow pages advertising, press releases and promotional flyers, distribution of business cards and correspondence on Ariel stationery.

4. Since the band was formed in 1981, the band has averaged one hundred and four (104) dates or two dates a week a year including 1995, 1996, 1997, 1998, 1999 and 2000. We play at hotels, on cruise ships, in clubs and restaurants, at Disney World, at corporate events, and at country clubs. We have performed in music festivals, on English and Spanish television, in Las Vegas, New Orleans, Nashville and San Antonio as part of a national tour for the television program "Entertainment U.S.A." in 1993. At all performances, the "Ariel" mark is prominently displayed.

5. Total sales from entertainment services have ranged from \$30,000.00 to \$100,000.00 a year.

6. The band is well known in Miami and the Southeast by the "Ariel" mark.

7. We have begun distributing worldwide our first CD under the "Ariel" mark.

8. Performing with the band "Ariel" has been my only job since the early 90's. It's the only work I do. It pays my rent. It supports my family. I intend to continue writing, playing and performing as long as possible.

Opposer also has submitted the declaration of Cliff Walker, who avers as follows, in pertinent part:

2. My company, Walker Entertainment, Inc. has represented the band Ariel since 1983 as its booker and promoter. Since that time I have booked the band in approximately two to ten venues a year from 1983 to the present. In addition, I am responsible for providing information regarding the entertainment services of the band Ariel to potential venues and engagements.

3. Upon request, I provide to potential venues promotional materials, flyers, and direct mails. The materials are all provided under the "Ariel" trademark.

*4 4. I have most recently booked entertainment services under the mark "Ariel" to the Sunfest Festival held May 3-7, 2000 in West Palm Beach, Florida. The Sunfest Festival is Florida's largest music, art and waterfront festival drawing 300,000 people. The performance by the band was held under a prominently displayed "Ariel" mark.

5. I also refer potential bookings to the "ariel-band.com" Web site for information regarding the band.

We find that the averments contained in these declarations are sufficient, if unopposed, to establish that opposer has used ARIEL as a mark for his musical entertainment services since a date prior to applicant's first use of the mark in January 1996, and that opposer's use of the mark has not been abandoned.

Applicant has not presented any counter-declarations or other evidence which rebuts the factual averments made in opposer's declarations, nor has applicant identified any genuine issue of material fact with respect to those averments. Instead, applicant argues that the declarations submitted by opposer are entitled to

no probative weight on the question of opposer's use and priority because they contain certain alleged internal contradictions which render the declarations untrustworthy in their entirety, and because opposer allegedly has failed to present sufficient corroborating documentation for all of the averments made in the declarations. We disagree.

Regarding the alleged internal contradictions in the declarations, applicant first contends (at page 4 of her reply brief) that "[i]n his Second Declaration, Opposer claims that he handles the advertising and promotion for the band's performances. (Remos Second Dec. ¶ 1). Opposer then claims that booking agents are actually responsible for the band's advertising and promotional activities." However, in paragraphs 1-2 of his second declaration, opposer actually avers as follows: "As the band's leader I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself. In addition, the band has several booking agents who book the band and also handle advertising and promotion of the band always under the 'Ariel' mark." (Emphasis added.) Thus, opposer states that he handles "most of" the advertising and promotion for the band, in addition to several booking agents who "also" handle the advertising and promotion. These statements are not contradictory.^(FN3)

Likewise, and contrary to applicant's contention, there is no contradiction between opposer's statement (in ¶ 4 of his second declaration) that "the band has averaged one hundred and four (104) dates or two dates a week a year," and Mr. Walker's statement (in ¶ 2 of his declaration) that he has "booked the band in approximately two to ten venues a year." As is apparent from ¶¶ 1-2 of Mr. Remos' second declaration, Mr. Walker is not the only booking agent for opposer's band. Opposer handles some of the booking himself, and the band also engages several other booking agents in addition to Mr. Walker. Thus, the fact that Mr. Walker books opposer's band for two to ten dates per year is not inconsistent with Mr. Remos' assertion that the band plays 104 dates per year.

*5 In short, applicant's contentions regarding the alleged internal contradictions in opposer's declarations are not borne out by the declarations themselves. We are not persuaded by applicant's argument that the declarations as a whole should be disregarded on account of the alleged contradictions.

Applicant also argues that the three declarations submitted by opposer should be disregarded in their entirety because the averments contained therein (as to the details of the nature, duration and extent of opposer's advertising and sale of his services under his mark) are not adequately corroborated by admissible, probative documentary evidence. For the reasons discussed below, we disagree.

Among the documentary exhibits to Mr. Remos' two declarations and to Mr. Walker's declaration are photocopies of programs, invitations, tickets and advertisements pertaining to various events and functions at which performances by opposer and his band were the featured musical entertainment.^(FN4) These documents, which were

prepared and distributed by the third-party sponsors of such events and functions, include, in chronological order of performance:

- (1) invitation to the April 30, 1988 Florida Customs Brokers and Forwarders Association "Gala Installation Banquet" in Miami, Florida, which states "Music by 'Ariel'";
- (2) invitation to the November 17, 1990 Cuban American National Foundation "Gala Dinner Dance" in Miami, Florida, which states "Music by Ariel";
- (3) ticket to the February 2, 1991 "LBA" benefit event in Miami, Florida, which states "Music by: Ariel";
- (4) program for the February 8, 1991 St. Thomas the Apostle "Eighth Annual Dinner Dance" in Key Biscayne, Florida, which states "Music by Ariel";
- (4.A) ticket to the same February 8, 1991 St. Thomas the Apostle Dinner Dance, which states "Music by: Ariel";
- (5) program for the March 7, 1992 Saint Patrick School "Gala Dinner Dance" (location undisclosed) which states "Music by Ariel";
- (6) ticket to the May 14, 1994 "Baptist Hospital Ball" in Miami, Florida, which states "Dancing to Music by Varon and Ariel";
- (7) invitation to the April 27, 1996 Florida Customs Brokers & Forwarders Association "Gala Installation Banquet" in Miami, Florida, which states "Music by 'Ariel'";
- (8) newspaper advertisement for the December 31, 1997 Doral Golf Resort and Spa "New Year's Eve Gala" in Miami, Florida, which states "Dance the Night Away with Renowned 6 pc. Band "Ariel";
- (9) program for the 1998 Asociacion Latinoamericana "Latin Fever Ball" in Atlanta (Buckhead), Georgia, which states "Dancing throughout the evening to the sound of Ariel"; and
- (10) Sunfest 2000 advertisement depicting the "Performance Schedule" for Saturday May 6, 2000, which includes a listing for a performance by "Ariel."

Applicant has not contended, nor has she presented any evidence which would suggest, that opposer and his band did not actually render musical performances at the events and functions identified in the above-referenced third-party documents. Instead, applicant asserts various evidentiary arguments against the admissibility of certain of the documents, and various legal arguments for the proposition that none of the documents establish that opposer has any service mark or other proprietary rights in ARIEL.

*6 We turn first to a consideration of applicant's evidentiary objections to certain of the above-referenced documents. Specifically, applicant has objected to the admissibility of the above-numbered documents (3), (4.A), (6), (7), and (9), which were attached as Exhibit Nos. 2(a) - (d) to Mr. Remos' second declaration.^(FN5) Applicant objects to these documents under Fed. R. Evid. 403, on the ground that they are merely cumulative of the documents which were attached to the first Remos declaration and are accordingly a waste of time. The objection is overruled. These additional documents, even if cumulative, are not so numerous as

to be wasteful of the parties' or the Board's time and efforts.

Applicant also objects to these documents under Fed. R. Evid. 901, on the ground that they are not properly authenticated. This objection is overruled. Applicant has not contended that these documents were manufactured or fabricated by opposer. Indeed, as applicant herself has argued, these documents were independently prepared and distributed by third parties, not by opposer. Any technical defect in the manner in which opposer introduced and authenticated these documents via his declaration is not dispositive, inasmuch as there simply exists no basis in the record for concluding that these documents are other than what they appear to be. See Fed. R. Evid. 901(a) and 901(b)(4).

Finally, applicant has objected to documents (3), (4.A), (6), (7), and (9) under Fed. R. Evid. 401 and 402, on the ground that they are not relevant to this action. This evidentiary objection is premised on applicant's substantive legal arguments regarding the alleged lack of probative value of all of the above-referenced third-party documents. For the reasons discussed below, we reject applicant's substantive legal arguments; we accordingly also overrule applicant's relevancy objections which are based on those arguments.

Applicant's first substantive argument is that none of the above-referenced documents are evidence of service mark use of ARIEL by opposer because they were not created or distributed by or on behalf of opposer for the purpose of advertising or promoting opposer's entertainment services to prospective purchasers of those entertainment services, i.e., to those who might engage opposer to provide musical entertainment services. Rather, the documents are advertisements, programs, invitations and tickets which were created and distributed by the various third-party organizations and sponsors themselves, to advertise and promote their own hotel, banquet, school dance and restaurant services to their members and/or to the general public. According to applicant, the designation ARIEL, as it appears in the documents, is not used as a service mark by opposer; rather, it is used by the third parties in a merely informational sense, to identify the musical entertainment the third parties are presenting as part of their hotel, banquet, school dance and restaurant services.

*7 We are not persuaded by this argument. Applicant cites no case law or statutory authority which supports her contention that these documents must be disregarded as evidence of opposer's use of the mark ARIEL merely because they were created and distributed by the third parties, rather than by opposer.^(FN6) Indeed, applicant herself has submitted and relies upon numerous documents of exactly the same type as evidence of her use of her own mark. On their face, opposer's documents show that opposer was engaged by the various third parties to provide musical entertainment services under the mark ARIEL at the identified events and functions. There is no basis in the record for concluding that opposer and his band did not, in fact, render musical entertainment services under the mark at those events and functions. The fact that the advertisements were prepared and distributed by third

parties rather than by opposer is inconsequential.

Applicant's second substantive argument with respect to these third-party documents submitted by opposer is that the designation ARIEL is used in these documents solely to identify opposer personally, and not as a service mark for opposer's entertainment services. We disagree. The newspaper advertisement for the Doral New Year's Eve Gala (document no. (8) above) specifically refers to the "Renowned 6 pc. Band 'Ariel.'" Likewise, there is no reasonable basis in the record for inferring that the other documents, when they use the designation ARIEL, are referring to opposer personally, rather than to the band.

In summary, we find that the above-referenced documents establish that opposer and his band were engaged to render, and did render, live musical performances under the mark ARIEL in 1988, 1990, 1991, 1992, 1994, 1996, 1997, 1998 and 2000. We find that the averments in opposer's summary judgment declarations regarding opposer's prior use and non-abandonment of the mark have been corroborated, at least to that extent.^(FN7) Taken together, the documents and the declaration averments are sufficient to establish opposer's Section 2(d) priority in this case.

Applicant makes two other arguments with respect to the priority issue which require comment. First, applicant has cited various authorities in support of the proposition that personal name marks, such as opposer's, are merely descriptive and not entitled to protection absent a showing of secondary meaning. However, applicant has not cited to any prior decisions of the Board or of its primary reviewing court in which this proposition has been stated or followed, and we are aware of no such decisions. For the reasons discussed below, we are not persuaded that we should follow the authorities cited by applicant on this issue.

A personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be inherently distinctive under the Lanham Act. Indeed, applicant's own mark ARIEL, which is also applicant's personal name, was not refused registration as merely descriptive, and was forwarded to publication by the Office without any requirement for a showing of acquired distinctiveness. We see no logical basis for holding that a personal name mark which is inherently distinctive for registration purposes must nonetheless be shown to have acquired secondary meaning before it can be relied upon by an opposer in an opposition proceeding. Thus, we reject applicant's argument regarding opposer's alleged failure to establish secondary meaning in his mark.

*8 Applicant also argues that she is entitled to an "adverse inference," and to dismissal of the opposition, due to opposer's alleged failure, despite the pendency of this proceeding, to retain discoverable documents. Applicant cites *Supreme Oil Co. v. Lico Brands, Inc.*, 39 USPQ2d 1695 (TTAB 1996) in support of this argument. However, *Supreme Oil Co.* involved a fully-briefed motion for discovery sanctions under Fed. R. Civ. P. 37. No such motion was filed by applicant in this

case; rather, the request for an adverse inference was raised by applicant for the first time in her reply brief. Opposer has had no opportunity to respond on the merits of applicant's request. In view thereof, we deny applicant's request for an unspecified "adverse inference" and her request for dismissal based thereon.

Having found that opposer has established his priority for purposes of Section 2(d), we turn now to the issue of likelihood of confusion. Our likelihood of confusion determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the respective marks and the similarities or relatedness of the respective goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

There is no genuine issue of material fact that applicant's mark and opposer's mark are identical, i.e., ARIEL. There also is no genuine issue of material fact that applicant's services, as recited in the application, are legally identical to opposer's services. In view of the absence of any limitations or restrictions in applicant's recitation of services, the purported differences in the parties' respective musical styles are immaterial. Likewise, we must presume from the absence of restrictions in applicant's recitation of services that applicant's services are offered in all normal trade channels and to all normal classes of purchasers for such services, including the trade channels and classes of purchasers in which and to whom opposer offers his legally identical services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). There is no evidence of any use by third parties of similar marks for similar services. These *du Pont* factors, as to which there are no genuine issues of material fact, all weigh heavily in favor of a finding of likelihood of confusion in this case.

The only *du Pont* factor which appears to favor applicant is the absence of evidence of actual confusion. However, we cannot conclude that the nature and extent of the parties' respective uses of their marks, to date, have been such that the absence of actual confusion should be accorded any significant weight in our likelihood of confusion analysis. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Certainly, that single factor is insufficient to overcome the numerous other *du Pont* factors which, as discussed above, clearly weigh in favor of a finding of likelihood of confusion.

*9 In summary, we find that there are no genuine issues of material fact as to any of the *du Pont* likelihood of confusion evidentiary factors. Having carefully considered all of the evidence of record as to those factors, we find that a likelihood of confusion exists. Having also found that no genuine issues of material fact exist with respect to opposer's standing and his Section 2(d) priority, we conclude that opposer is entitled to judgment as a matter of law on his Section 2(d) claim. Therefore, we grant opposer's motion for summary judgment, and deny

applicant's cross-motion for summary judgment.

Decision: The opposition is sustained.

FN1. Serial No. 75/476,262, filed April 29, 1998. In the application, applicant alleges use of the mark since January 14, 1996, and use of the mark in commerce since April 1, 1996.

FN2. Applicant's objection to opposer's sur-reply brief is well-taken, and we have given that paper no consideration. See Trademark Rule 2.127(e) (1).

FN3. To arrive at her conclusion that the statements in ¶¶ 1 and 2 of opposer's second declaration are contradictory, applicant apparently construes opposer's statement (in ¶ 1 of his declaration), i.e., "I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself," such that the words "most of" modify only the words "the financial matters" and not the words "the advertising and promotion." Another valid construction, however, and one which is more likely to be correct because it allows ¶¶ 1 and 2 to be read together without contradiction, is that the words "most of" modifies both "the financial matters" and "the advertising and promotion."

FN4. As discussed *infra*, we find that these third-party documents are sufficient to corroborate and establish opposer's claim of prior, non-abandoned use of his mark. Opposer has submitted various other documents as well, to which applicant has objected on various grounds. In general, we are not persuaded by applicant's objections. However, because we find that opposer's priority claim is sufficiently established by the documents discussed in the text of this opinion, we need not and do not base our decision on these other documents of opposer's, nor do we rule specifically on applicant's objections thereto.

FN5. Applicant raised no specific evidentiary objections to the admissibility of above-numbered documents (1), (2), (4), (5), (8) and (10), and any such objections to those documents are deemed waived. See Fed. R. Evid. 103(a). Applicant's various substantive legal arguments regarding the probative value of all of the above-referenced documents (Nos. (1)-(10)) will be discussed below.

FN6. Applicant cites to TMEP §1304.01, which sets forth a non-exclusive list of types of documents which are acceptable as specimens in service mark applications. That section is not apposite to or dispositive of the priority dispute in this opposition proceeding.

FN7. It is not dispositive that opposer's documents do not corroborate each and every detailed averment made in opposer's declarations, i.e., as to the specific dollar amounts of opposer's sales and advertising, or as to the geographic scope of opposer's use of the mark. Opposer need not substantiate each of those specific averments in order to establish his Section 2(d) priority, vis-à-vis applicant.

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on this 16th day of January 2009.


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